

## **REMARKS**

### **Claim Rejections – 35 USC §102**

Claims 63-106 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,258,125 to Paul et al. (hereafter “the ‘125 patent”). The ‘125 patent is the only reference that has been asserted against the pending claims.

### **Declaration of Prior Invention in the United States Under 37 C.F.R. §1.131**

The Applicant submits herewith a Declaration of Prior Invention in the United States under 37 C.F.R. §1.131 to remove the ‘125 patent as prior art. The ‘125 patent application was filed on July 30, 1999, and claims the benefit of U.S. Provisional Patent Application Serial No. 60/095,209 filed August 3, 1998. Accordingly, the ‘125 patent has a purported effective filing date of August 3, 1998. The Applicant reserves the right to challenge the purported effective filing date of the ‘125 patent.

The Declaration has been signed by each of the joint inventors and indicates that on a date prior to August 3, 1998, the Invention was conceived of and reduced to practice in the United States. To evidence conception and reduction to practice of the Invention, attached to the Declaration is an Invention Disclosure including drawings and a description of the Invention which correspond to the subject matter disclosed and claimed in the subject patent application. The dates listed on the Invention Disclosure have been blacked out, as well as dimensional data associated with the Invention. However, the joint inventors have declared that the “Date of Conception” and the “Date Constructed” occurred prior to August 3, 1998.

The Declaration also indicates that on a date prior to August 3, 1998 and shortly after the Invention was reduced to practice, the Invention was tested in the United States. The joint inventors have declared that the “Date First Tested” listed on the Invention Disclosure occurred prior to August 3, 1998. Following construction and testing of the Invention, the Invention Disclosure was forwarded to the law firm of Woodard, Emhardt, Naughton, Moriarity & McNett for preparation of a patent application. A patent application disclosing and claiming the Invention was filed with the U.S. Patent and Trademark Office on October 28, 1998. (U.S.

Patent Application Serial No. 09/181,353; issued as U.S. Patent No. 6,174,311). The subject patent application claims priority to the parent patent application filed on October 28, 1998.

The Applicant submits that the attached Declaration is effective to remove the '125 patent as prior art to the subject application. Accordingly, the Applicant respectfully requests withdrawal of the rejection of claims 63-106 under 35 U.S.C. §102(e) as being anticipated by the '125 patent. However, the Applicant reserves the right to refute the claim rejections set forth in the Office Action should the Declaration for any reason be deemed ineffective to remove the '125 patent as prior art.

The Applicant further submits that many of the claims which have been rejected in the Office Action as being anticipated by the '125 patent are indeed patentable over the teachings of the '125 patent. For example, and without limitation, claim 65 recites that "said bone portion if formed from a donor bone segment having at least a portion of a medullary canal and the concave surface defines a portion derived from the medullary canal". The '125 patent fails to teach or suggest that either of the implants 70, 70' are formed from a donor bone segment having at least a portion of a medullary canal with the space 72 derived from the medullary canal.

Claim 72 recites that the first and second bone engaging surfaces "are separated by a first height adjacent to a first end and by a second height adjacent an opposite, second end, wherein said first height is greater than said second height". Claim 101 recites similar subject matter. However, the implants 70, 70' illustrated in Figure 9 of the '127 patent have a uniform, non-varying height between the first and second ends.

Claim 78 recites that the first end wall includes "a recess extending to the concave surface". Even assuming arguendo that the channel 20 formed along the side of the implants 70, 70' comprises a recess, the channel 20 does not extend to the curved inner surface which defines the space 72. Indeed, the channel 20 is positioned on the side of the implant opposite the curved inner surface of the space 72.

Claim 79 recites that the first end of the implant includes "a bore extending parallel to the longitudinal axis" of the implant. Claim 80 further recites that "the bore is threaded". The channel 20 formed along the side of the implants 70, 70' does not comprise a bore, much less a threaded bore.

Independent claim 82 recites “a first sidewall comprising a concave surface” and “a second, opposite sidewall comprising a convex surface”. Even assuming arguendo that the curved inner surface of the implants 70, 70’ which defines the space 72 comprises a concave surface, the sidewall opposite the curved inner surface defines a flat or planar surface, and not a convex surface, as recited in independent claim 82.

Claim 86 recites that the pair of spinal implants “do not contact each other”. However, as disclosed in the ‘125 patent, the implants 70, 70’ are engaged to one another via the locking pins 76 which are positioned in the apertures 76. (Column 5, lines 8-23).

Claim 87 recites that the pair of spinal implants “are positioned to lie at an angle oblique to each other”. However, the implants 70, 70’ illustrated in Figure 9 of the ‘125 patent are positioned parallel to one another.

Claim 98 recites that the second side wall of the implant opposite the first side wall defining the cavity includes “a curved portion”. Claim 106 recites similar subject matter. Even assuming arguendo that the side wall of the implants 70, 70’ which defines the space 72 includes a cavity, the sidewall opposite the curved inner surface is flat or planar and does not include a curved portion.

Claim 103 recites that the tool engaging recess defined at the first end of the implant comprises “a slot extending to the cavity” defined by the first sidewall of the implant. Even assuming arguendo that the channel 20 formed along the side of the implants 70, 70’ comprises a slot, the channel 20 does not extend to the space 72 defined by the sidewall of the implant. Indeed, the channel 20 is positioned on the side of the implant opposite the space 72.

## CONCLUSION

The Applicant respectfully requests entry of this Amendment and consideration and allowance of the subject application including pending claims 63-106. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

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